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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/725,889	12/02/2003	Robert J. Barsotti	FA1133USNA	3390

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LEGAL PATENT RECORDS CENTER
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EXAMINER

BOYKIN, TERRESSA M

ART UNIT

PAPER NUMBER

1711

DATE MAILED: 06/24/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary	Application No. 10/725,889	Applicant(s) BARSOTTI ET AL.	
	Examiner Terressa M. Boykin	Art Unit 1711	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 December 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>12/03</u> . | 6) <input type="checkbox"/> Other: _____ |

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Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-13 are rejected under 35 U.S.C. 102(e) as being anticipated by US 2002/0161135 note abstract, pages 1-4 and examples, claims 1, 2 or 30 - 32.

The reference USP 20020161135 discloses a coating composition comprising a first compound comprising at least one bicyclo- or spiro-orthoester group and a second compound comprising at least two hydroxyl-reactive groups. The invention also comprises a process for curing the present coating composition. More particularly, the latent hydroxyl groups of the bicyclo- or spiro-orthoester groups have to be deblocked and reacted with the hydroxyl-reactive groups of the second compound if the present coating composition is to be cured. Further, a process for making bicyclo-orthoester compounds from the corresponding oxetane compound is described, as are polymers comprising at least one bicyclo- or spiro-orthoester group. In addition to the disclosed BOE- and SOE-functional compounds and said hydroxyl-reactive compounds other compounds may be present in the coating composition according to the present invention. Such compounds may be main binders and/or reactive diluents comprising reactive groups which may be cross-linked with the aforesaid hydroxyl-functional compounds and/or hydroxyl-reactive compounds. Examples include hydroxyl-functional binders, e.g., polyester polyol. The ratio of hydroxyl-reactive groups to hydroxyl groups ranges from 50 to 300 eq. %, preferably from 70 to 250 eq. %.

The reference notes that use of compounds comprising bicyclo- or spiro-orthoester groups in coating compositions has several advantages over the use of compounds having free hydroxyl groups, such as hydroxyl-functional reactive diluents, hydroxyl-functional main binders, e.g. polyester polyols and acrylate polyols, and even compounds where the bicyclo- or spiro-orthoester groups have already been hydrolyzed. The applied coating composition can be cured very effectively at a temperature of, e.g., 0-50 degrees C. The coating composition may be baked, e.g., at a

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temperature in the range of 50-120 degrees C. The present BOE-functional compound can be prepared in several ways. With regard to the use of a noncyclic orthoester, note that the reference discloses that the composition may be prepared by the use of transesterification of a polyol in an appropriate solvent. Examples of such polyols include glycerol, trimethylol propane, and pentaerythritol. The transesterification agent can be a trialkyl orthoester selected from the group of triethyl orthoformate, triethyl orthoacetate, and triethyl orthopropionate. Preferably, use is made of solvents which are inert to the transesterification reaction, e.g., diethylene glycol dimethyl ether and tetraethylene glycol dimethyl ether.

Advantages over existing Medium Solid 2k primer/filler materials as used in the car refinish market nowadays are: a very low VOC, a long potlife and a high build behavior. Compared to existing High Solids primer compositions comprising imine crosslinkers advantages are again a long potlife, fast drying at 60 degree C, and the fact that there is no emission of volatile blocking components (like aldehydes and ketones from crosslinkers such as ketimines, aldimines and oxazolidines).

In view of the above, there appears to be no significant difference between the reference and that which is claimed by applicant(s). Any differences not specifically mentioned appear to be conventional. Consequently, the claimed invention cannot be deemed as novel and accordingly is unpatentable.

Correspondence

Please note that the cited U.S. patents and patent application publications are available for download via the Office's PAIR. As an alternate source, all U.S. patents and patent application publications are available on the USPTO web site (www.uspto.gov), from the Office of Public Records and from commercial sources. Applicants may be referred to the Electronic Business Center (EBC) at <http://www.uspto.gov/ebc/index.html> or 1-866-217-9197.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Terressa Boykin whose telephone number is 571 272-1069. The examiner can normally be reached on Monday through Friday from 6:30am to 3:00pm.

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The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306. The general information number for listings of personnel is (571-272-1700).

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

tmb

A handwritten signature in black ink, appearing to read "Terressa Boykin".

Examiner Terressa Boykin
Primary Examiner
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